

REMARKS/ARGUMENT

Claims 13-22 are newly added and are presented for examination. Claims 1-4, 6-9 and 12 have been cancelled. Claim 13 is the only independent claim. Changes to the specification have been effected. The changes are for clarification and are not believed to add new matter.

Initially, Applicant thanks the Examiner for having initialed and returned the initialed copy of the PTO-1449 form filed with the submission dated June 20, 2001. Applicant notes, however, that the Office Action did not include an initialed copy of the PTO-1449 forms filed with the original application papers. It is requested that the Examiner initial that paper as well and return it in the next Office Action. For the convenience of the Examiner, another duplicate of that PTO-1449 form is submitted herewith.

Claims 1, 4 and 6-8 were rejected under 35 U.S.C. § 103 over Nanjo (JP 406119363A), which is the art discussed in the Background of the Invention of the specification, in view of Tabata (JP410143414A) and further in view of U.S. Patent 5,818,955 (Smithies). Claims 2-3 were rejected under 35 U.S.C. § 103 over Nanjo in view of Tabata and further in view of Smithies, and further in view of U.S. Patent 6,401,206 (Khan et al.). Claims 9-12 were rejected under 35 U.S.C. § 103 over Nanjo in view of Tibata and Smithies and further in view of U.S. Patent 4,286,255 (Siy). Applicant submits that the claims are patentable over the cited references for at least the following reasons.

Claim 13 is directed to a document management system comprising: (a) a document data storage system; (b) a plurality of attest data storage systems; and (c) a plurality of computer systems, each operating as a terminal, the document data storage system, the plurality of attest data storage systems and the plurality of computer system being coupled together on a network securely coupled to outside the network. The document data storage system has an ID number associated therewith, the document data storage system storing and

managing an electronic document and, for any stored electronic document, storing a document number associated with the document, and attest data, the attest data comprising signature image data, a signer ID number, an ID number of the attest data storage system associated with the document, and a serial usage number relating to the document. When a person utilizing one of the computer terminals, and authorized to access the document data storage system and the electronic document, requests a display or printing of image data of the document, the document data storage system displays or prints data of a total image of the requested electronic document, the total image comprising the electronic document, a document name, the document number, the ID number of the document data storage system, as well as attached bar codes representing the document and ID numbers, one or more signature images, the signer ID number including the ID number of the attest storage system, the serial usage number of the signature image data, and attached bar codes representing the numbers in the vicinity of the original signature image.

Nanjo is extensively discussed in the background section of the present application. Nanjo teaches, inter alia, a system that delivers document data after synthesizing the document data with signature image data. Nanjo has a signature image data unit and a document data unit in a single closed computer system, not in a distributed system connected to a network, as in claim 13. In Nanjo, private information and different documents are stored in the single computer, with different passwords and document data and the signature image are printed as output data. Moreover, Nanjo does not teach or suggest printing signer ID numbers, as in claim 13.

Tabata teaches the addition of a two-dimensional bar code (it is presumed that the translation is incorrect in referring to a “three dimensional bar code,” since three dimensions cannot be printed on a sheet of paper) to a document. However, Tabata does not relate to the field of the present invention, in which signature images, their ID numbers, and bar codes are shown in the print or print view, and in which signature images are used to show evidence

of approval, and bar codes are used to verify the correctness of the signature by accessing the document data storage system, or the attest data storage system. Tabata simply uses bar codes in managing storage of documents in an electronic data base. Tabata contains no teachings of any of the abovementioned features of the claimed invention and even when combined does not remedy the deficiencies of Nanjo discussed above. Smithies teaches a method of electronically capturing a signature image, but does not remedy the above-referenced deficiencies of Nanjo and Tabata as references against claim 13.

For at least the foregoing reasons, claim 13 is believed patentable over the cited references.

Further, the piecemeal application of unrelated features of unrelated documents that has been used in this case to meet the features of the claims of the present application is objected to. To support a prima facie case of obviousness requires, among other things, that a motivation be identified, in the prior art itself, that would have caused one of skill in the art to make any proposed modification of the primary reference or to combine references. Further, if more than two references are combined, the motivation must be to combine *all three references*. This is because there must be a motivation to make the *two-fold modification* of the primary reference.

In the Office Action, in reference to now-cancelled claim 1, the Examiner took the position that it would have been obvious to combine Tabata et al. with Nanjo to provide the features relating to the use of barcodes. However, the Examiner took the position that it would have been obvious to include the above features of Tabata with the Nanjo because it would add "efficiency to the system."

As was explained in the previous amendment relating to a different feature, the fact that an advantageous feature of the applicant's invention increases efficiency is *not* evidence that it would have been obvious to have added the feature that promotes such efficiency. On

the contrary, the fact that the prior art has no teaching or suggestion of a feature, combined with the fact that the feature is particularly advantageous, is evidence of *non*-obviousness, not its opposite. If the rule followed in the Office Action were followed, then the most advantageous inventions would be the most obvious. Of course this is not true. Thus, the motivation for the initial modification of Nanjo to include the features of Tabata is deficient and for at least this reason no *prima facie* case of obviousness has been established.

Moreover, the Office Action is equally deficient in the motivation provided for making the *further* modification to allegedly meet the feature of the attest data storing the ID number. It is conceded in the Action that even when combined, Nanjo and Tabata do not teach this feature. Smithies is cited as remedying this deficiency. The motivation provided is that “it would have been obvious to combine the teachings of Smithies et al. within the combination of Nanjo and Tabata because it would have increased security through the additional identification information.”

However, it is not sufficient in a three-way combination to provide motivation in a step-wise or serial manner. There must have been motivation in the prior art, and that motivation must be identified by the Examiner, to combine *all of the references* to meet the claim *as a whole*. The motivation provided in the Office Action for the additional modification to include the features of Smithies is stated in terms of why it would have been obvious to modify *the combination* of *Nanjo and Tabata*, treating that combination as a given, and thus fails to provide the required motivation.

By treating the initial combination as a given, the motivation provided for the further modification is not sufficient since it does not even allege to constitute motivation to make *the entire combination*. The motivation provided is completely deficient at least because it is a motivation to modify a hypothetical construct, namely the combination of Nanjo and

Tabata, that is, a motivation to modify something that does not exist. For this additional reason, no prima facie case of obviousness was set forth in the Office Action.

Moreover, even the alleged motivation provided in the Office Action is improper since it simply says that by adding another security step, more security would be provided. In addition to the fact discussed in the foregoing paragraphs that this would not be a motivation to make the double modification required to meet the claim, it is also deficient because it would apply to any security feature added in any claim. If it were sufficient to state that adding features that do "A" would have been obvious because then you would have "A," then no improvement would be patentable. A motivation to combine cannot simply be a statement of the effect of the element in question and then a statement that it would have been obvious because then you get that effect. For this additional reason, no prima facie case has been set forth.

As was pointed out in the previous response, the only motivation for adding barcodes to Nanjo's system is the motivation to meet this feature of the claim, which is, of course, improper, and in fact amounts to a hindsight reconstruction of the claim. The additional motivation to make the modification of the hypothetical combination of Nanjo and Tabata also is deficient for the reasons given above. For at least this reason, any rejection based upon the combination of references as described in the Office Action would be improper.

The other claims in this application are each dependent from the independent claim discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

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Respectfully submitted,

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